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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,120	10/01/2003	David C. Lowery	1201.158.102 (10354US02)	3904
7590	10/09/2007		EXAMINER	
David C. Lowery P.O. Box 64898 St. Paul, MN 55164-0898			RICKMAN, HOLLY C	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/677,120

Applicant(s)

LOWERY ET AL.

Examiner

Holly Rickman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 and 16-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 16-19 and 21-27 is/are rejected.
- 7) ☒ Claim(s) 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The rejection of claims 16-24 under 35 U.S.C. 112, first paragraph, is withdrawn in view of Applicant's arguments.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10, 16, 19, and 21-23, 25-27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mori et al. (US 5510168).

Mori et al. disclose a magnetic recording tape having a non-magnetic substrate and upper and lower magnetic layers thereon. The layers contain iron particle such as Co-containing iron oxide and an abrasive material such as alumina (corresponding to the claimed "head cleaning agent") dispersed in a binder. The reference discloses an example wherein the amount of

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alumina (head cleaning agent) is present in an amount of 10 pbw based on 100 pbw of magnetic metal powder. See col. 5, lines 27-32; col. 11, lines 1-20.

The reference does not disclose the claimed abrasivity indices of the recording medium. The examiner takes the position that the structure taught by Mori et al. inherently satisfies the claim limitations directed to abrasivity index by virtue of the fact that the reference discloses a structure that is substantially the same as claimed (i.e., magnetic metal particles containing Fe dispersed in a binder with an alumina head cleaning agent).

It has been held that where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the burden of proof is shifted to applicant to show that prior art products do not necessarily or inherently possess characteristics of claimed products where the rejection is based on inherency under 35 USC §102 or on prima facie obviousness under 35 USC §103, jointly or alternatively. *In re Best, Bolton, and Shaw*, 195 USPQ 430. (CCPA 1977).

With regard to the limitations of claims 8-9, it is the examiner's position that the recitations of a DLT tape are recitations of intended use. The recording medium taught by the prior art are substantially the same as claimed are therefore, would be expected to be capable of functioning in the claimed capacity. These limitations do not add any structural features to the magnetic recording medium defined in claim 1 and therefore, do not patentably distinguish over the prior art.

Claims 21-22 include process limitations in article claims. These limitations do not present any patentable distinction over the applied prior art. It has been held that even though product-by-process claims are limited and defined by the process, determination of patentability

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is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claim 23 is directed to the recording density of the claimed medium. Recording density is a function of the material properties of the recording medium itself along with the particular recording head structure and recording process used. As such the examiner takes the position, the recording medium taught by Mori et al. is capable of functioning in the claimed capacity by virtue of the fact that the reference teaches a recording layer which is substantially the same as claimed in structure and composition.

5. Claims 1-10, 16-19, and 21-26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kakuta et al. (US 6037051).

Kakuta et al. disclose a magnetic recording tape having a non-magnetic substrate and multiple magnetic layers thereon. The layers contain iron particles and an abrasive material such as alumina (corresponding to the claimed "head cleaning agent") dispersed in a binder. The reference discloses an example wherein the amount of alumina (head cleaning agent) is present in an amount of 10 pbw based on 100 pbw of magnetic metal powder. See col. 13, Ex 6; col.3, lines 28-36; col. 5, lines 57-63. The magnetic layers contain carbon black having a particle size of as low as 20 nm (col. 6, lines 5-22). Kakuta et al. teaches that the magnetic recording layer is subjected to a burnishing process. More specifically the reference teaches that a lapping method can be used (col. 3, lines 37-57; col. 11, line 62 to col. 14, line 20).

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The reference does not disclose the claimed abrasivity indices of the recording medium. The examiner takes the position that the structure taught by Kakuta et al. inherently satisfies the claim limitations directed to abrasivity index by virtue of the fact that the reference discloses a structure that is substantially the same as claimed and is made by a substantially similar method (i.e., burnishing method used).

It has been held that where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the burden of proof is shifted to applicant to show that prior art products do not necessarily or inherently possess characteristics of claimed products where the rejection is based on inherency under 35 USC §102 or on prima facie obviousness under 35 USC §103, jointly or alternatively. *In re Best, Bolton, and Shaw*, 195 USPQ 430. (CCPA 1977).

With regard to the limitations of claims 8-9, it is the examiner's position that the recitations of a DLT tape are recitations of intended use. The recording medium taught by the prior art are substantially the same as claimed are therefore, would be expected to be capable of functioning in the claimed capacity. These limitations do not add any structural features to the magnetic recording medium defined in claim 1 and therefore, do not patentably distinguish over the prior art.

Claim 23 is directed to the recording density of the claimed medium. Recording density is a function of the material properties of the recording medium itself along with the particular recording head structure and recording process used. As such the examiner takes the position, the recording medium taught by Kakuta et al. is capable of functioning in the claimed capacity

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by virtue of the fact that the reference teaches a recording layer which is substantially the same as claimed in structure and composition.

***Claim Rejections - 35 USC § 103***

6. Claims 17 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (US 5510168).

Mori et al. disclose a magnetic recording tape having a non-magnetic substrate and upper and lower magnetic layers thereon. The layers contain iron particles and an abrasive material such as alumina (corresponding to the claimed "head cleaning agent") dispersed in a binder. The reference discloses an example wherein the amount of alumina (head cleaning agent) is present in an amount of 10 pbw based on 100 pbw of magnetic metal powder. See col. 5, lines 27-32; col. 11, lines 1-20.

The reference does not disclose the claimed abrasivity index of the recording medium. The examiner takes the position that the structure taught by Mori et al. necessarily satisfies the claim limitations directed to abrasivity index by virtue of the fact that the reference discloses a magnetic recording layer structure that is substantially the same as claimed (i.e., magnetic metal particles containing Fe dispersed in a binder with an alumina head cleaning agent).

It has been held that where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the burden of proof is shifted to applicant to show that prior art products do not necessarily or inherently possess characteristics of claimed products where the rejection is based on inherency under 35 USC

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§102 or on prima facie obviousness under 35 USC §103, jointly or alternatively. *In re Best, Bolton, and Shaw*, 195 USPQ 430. (CCPA 1977).

Mori et al. teaches all of the features of the claims as detailed above except for the use of carbon black having a particle size of less than 20 nm. Mori et al. discloses a lower layer containing carbon black having a particle size of 300 nm or less. It is well known to those of ordinary skill in the art that carbon black is a conductive material.

Given the disclosure of a range which overlaps the presently claimed range of “less than 20 nm”, it would have been obvious to one of ordinary skill in the art at the time of invention to choose a carbon particle size of less than 20 nm from the range of 300 nm or less given the apparent equivalence of all values within the range disclosed by Mori et al.

#### ***Allowable Subject Matter***

7. Claim 20 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

8. Applicant's arguments filed 7/16/07 have been fully considered but they are not persuasive.

Applicant argues that evidence of record established that Kakuta and Mori do not inherently satisfy the claimed Abrasivity Index limitation. Applicant argues the magnetic tape taught by Kakuta “could reasonably be considered similar to the Comparative Example 1



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media...having an Abrasivity Index of 1310 microinches.” Applicant also maintains that the magnetic tape of Mori et al. “could reasonably be considered similar to the media described in Comparative Example 2...having an Abrasivity Index of 449.”

The Examiner maintains that the arguments of counsel cannot take the place of evidence in the record. See *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965).

Applicant’s position that “the burnishing in Kakuta is likely to result in an abrasivity index of greater than 1,000 microinches” is not sufficient to establish that Kakuta does not inherently meet the claimed Abrasivity Index limitations. Likewise, Applicant’s statement that Mori “could reasonably be considered similar” to a comparative example described in the specification is not sufficient to rebut the prima facie case of anticipation. See MPEP 2112 section V. for further discussion.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Rickman whose telephone number is (571) 272-1514. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Holly Rickman  
Primary Examiner  
Art Unit 1773

hr  
October 1, 2007